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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Matthew Vacek et al.
Title: COMPOSITE SOFTBALL BAT

Docket No.: 1470.001US1
Filed: June 18, 2001
Examiner: Mark Graham
Serial No.: 09/883,790
Due Date: September 8, 2004
Group Art Unit: 3711

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- ☒ A return postcard.
- ☒ Reply Brief under 37 C.F.R. 1.193(b) (5 pgs.; IN TRIPLICATE.).

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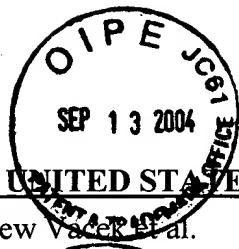
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(GENERAL)

S/N 09/883,790



PATENT

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REPLY BRIEF UNDER 37 CFR 1.193(b)

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This Reply Brief is filed in triplicate and presented in response to the Examiner's Answer (the "Answer") dated July 8, 2004. The Appellants respectfully request acknowledgment of receipt, and entry of this Reply Brief in the above-identified Application for review by the United States Patent and Trademark Office Board of Patent Appeals and Interferences (the "Board").

REPLY

A. Examiner's Claim 1 Argument: In the Examiner's answer mailed July 8, 2004, the Examiner acknowledges that the second outer tubular member of the Uke reference (US Patent 5,303,917) is termed a "protective sleeve" in the Uke reference. The Examiner asserts that all that the claim requires is that "...a sleeve be positioned within the hitting surface, that both the sleeve and hitting surface be of composite materials; and that the sleeve and hitting surface both be of fibers and resin wherein the first and second resins are different." (See page 3 of Examiner's Answer). The Examiner also asserts that "The fact that appellant denotes his inner cylindrical member to be a sleeve, while Uke calls the outer cylindrical member the sleeve is irrelevant to what physical structure is actually shown. The Examiner goes on to assert that in both instances the hitting surface is inherently the outer surface of the hitting portion. (See first full paragraph on page 4 of the Examiner's Answer). The Examiner also states that "...the handle (which has an upper portion extending into the hitting surface and is considered the 'sleeve' by the examiner) may be made of nylon while the barrel is formed of 'softer ABS/nylon

alloy.” (See beginning of last paragraph on page 4 of the Examiner’s Answer).

B. Appellant’s Response to Examiner’s Claim 1 Argument: Appellant asserts that the position set forth in the Appeal Brief correctly interprets the Uke reference. Appellant asserts that the Uke reference correctly interprets the structure, namely that the second outer tubular element 60, which Uke refers to as a “protective sleeve”, is a sleeve positioned on the outside of the hitting surface. The adjective protective indicates that the sleeve protects the barrel of the bat. Claim 1 recites “...a hitting surface; a handle element attached to the hitting surface; and **a sleeve positioned within the hitting surface**, wherein the hitting surface and the sleeve are comprised of composite materials...” (emphasis added). According to Uke, the “...second or outer tubular member 60 is a protective sleeve which engages telescopically over the inner member 58...” (See column 6, lines 35-38). The protective sleeve 60 of Uke is outside of inner member 58. The identical invention must be shown in as complete detail as is contained in the claim. Simply put, Uke fails to show the identical invention since a protective sleeve is positioned outside the inner member. The sleeve is not within the hitting surface as recited in claim 1.

Even if one were to interpret the Uke reference as suggested by the Examiner, namely that the hitting surface is inherently the outer surface of the hitting portion of the bat even though the Uke reference calls the element a protective sleeve, Applicant asserts that the Examiner still fails to make a *prima facie* case of anticipation. The Examiner admits that “...the handle...has an upper portion extending into the hitting surface and is considered the ‘sleeve’ by the examiner...” (See beginning of last paragraph on page 4 of the Examiner’s Answer). In other words, the handle is attached to the sleeve or is the sleeve. This interpretation fails to meet the structural requirements of claim 1.

Appellant also disagrees with the Examiner’s interpretation of claim 1 which essentially eliminates the handle element of the claim. Claim 1 recites “...a hitting surface; **a handle element attached to the hitting surface**; and a sleeve positioned within the hitting surface, wherein the hitting surface and the sleeve are comprised of composite materials...” (emphasis added). If the hitting surface is the outer surface, then Uke again falls short of the claimed invention which requires that the handle element attached to the hitting surface. If the

Examiner's interpretation is taken, namely that the sleeve 60 of Uke is the hitting surface, then Uke's hitting surface (the outer tubular member 60) is not attached to the handle. Rather the handle is attached to the inner member 58 rather than to the hitting surface. The second or outer tubular member 60 stops short of the handle. The handle is attached to the inner member 58. Even if the Examiner's interpretation of Uke is considered the correct interpretation, the Uke reference still falls short of the language of claim 1, since the handle is attached to the sleeve and not attached to the hitting surface.

C. Examiner's Claim 3 Argument: With respect to claim 3, the Examiner contends that "Uke...teaches varying the stiffnesses of the two elements as desired by the particular batter. Obviously Uke leaves the exact stiffness up to the ordinary skilled artisan. In light of such a teaching appellant's recitation of one such possible stiffness being three times the other cannot be considered an unobvious distinction, absent some showing of unexpected results resulting from the particularly claimed relative stiffnesses. Appellant has offered no such shown and Appellant has otherwise failed to rebut the prima facie case of obviousness. Nor did appellant request supporting evidence of notice taken by the examiner as to the facts known in the art, in light of Uke, in response to the rejection in the original office action. As such, appellant acquiesced to the notice so taken by the examiner and the current request for evidence supporting official notice is now moot."

The Examiner also noted that the other arguments over claim 3 as to the included limitations of claim 1 should be looked at in light of the Examiner's arguments regarding claim on in the Examiner's Answer.

D. Appellant's Response to Examiner's Claim 3 Argument: Appellant did not acquiesce as to the notice taken. Applicant refuted the Examiner's initial argument as to the obviousness of claims 3, 5 and 7 (see argument starting on page 4 and specifically the first full paragraph on page 5 in the response to the first office action dated February 19, 2003. Applicant specifically argued that the Uke reference did not teach or suggest a stiffness of the sleeve approximately 3 times the stiffness of the hitting surface in response to the Examiner's initial rejection. With respect to claims 3, 5 and 7, the Examiner initially brought up "...knowledge

generally available to one of ordinary skill in the art..." in the second, final office action (see bottom of page 3 and page 4 in the second office action dated May 1, 2003). Appellant met this argument with, among other arguments, with an objection to the taking of official notice with a single reference obviousness rejection (see page 9 of the response dated May 1, 2003). Accordingly, Appellant asserts that he did seasonably traverse the well known statement during examination and therefore did not acquiesce to the Examiner's personal knowledge.

With respect to the Examiner's Answer, claim 3 includes the limitations of claim 1. As set forth above, the Examiner has failed to make out a prima facie case of anticipation. In addition, the Examiner has also failed to make out a prima facie case of obviousness since Uke fails to teach or suggest all the elements of claim 3.

The Examiner's interpretation of the protective sleeve being the hitting surface, set forth in the Examiner's Answer, also makes claim 3 not obvious. Claim 3 recites that "...the hitting surface has a first stiffness and the sleeve positioned within the hitting surface has a second stiffness different than the first stiffness, wherein the second stiffness is approximately 3 times the stiffness of the first stiffness." Claim 3 thus claims that the stiffness of the sleeve within the hitting surface is higher than the stiffness of the hitting surface. Uke states just the opposite in that the "...second or outer tubular member 60 is a protective sleeve...of a material having a lower flex modulus than that forming the inner member 58." (see column 6, lines 35-39 of Uke). The flex modulus refers to the rate at which a material deflects (bends or sags) as weight is put on it. The second or outer tubular member having a lower flex modulus, thus, has a stiffness greater than the inner sleeve contrary to the recitation of claim 3.

E. Appellant's Response to Examiner's Claims 5, 7 and 8 Argument: Appellant argued claims 3, 5, 7 and 8 in the same areas of the responses during prosecution. Therefore, referring to the argument made with respect to claim 3 above, Appellant submits that the Examiner's arguments with respect to claims 5, 7 and 8 were seasonably traversed. Accordingly, the current request for evidence supporting official notice is not moot.

CONCLUSION

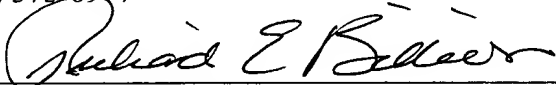
Because the reference does not anticipate the claimed invention nor render the invention claimed obvious, the Applicant respectfully requests the Board to reconsider the rejection and allow the claims. The Examiner is invited to telephone the undersigned to facilitate prosecution of this Application. Should the Board be of the opinion that any rejected claim is allowable in amended form, an explicit statement to that effect is also respectfully requested. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MATTHEW VACEK ET AL.

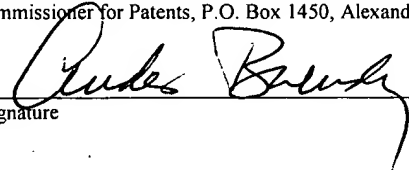
By their Representatives,

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